

ESTTA Tracking number: **ESTTA740181**

Filing date: **04/14/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

### Opposers Information

Name	MSC Services		
Entity	Corporation	Citizenship	New York
Address	75 Maxess Road Melville, NY 11747 UNITED STATES		

Name	Sid Tool Co., Inc.		
Entity	Corporation	Citizenship	New York
Address	75 Maxess Road Melville, NY 11747 UNITED STATES		

Attorney information	Michael R. Graif Curtis, Mallet-Prevost, Colt & Mosle LLP 101 Park Avenue New York, NY 10178 UNITED STATES trademarks@curtis.com, mgraif@curtis.com, kmeehan@curtis.com Phone:2126966000		
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### Applicant Information

Application No	86783572	Publication date	03/15/2016
Opposition Filing Date	04/14/2016	Opposition Period Ends	04/14/2016
Applicant	Roto-Die Company, Inc. 800 Howerton Lane Eureka, MO 63025 UNITED STATES		

### Goods/Services Affected by Opposition

Class 007. First Use: 0 First Use In Commerce: 0  
All goods and services in the class are opposed, namely: Dies for use with machine tools

### Applicant Information

Application No	86783562	Publication date	03/15/2016
Opposition Filing Date	04/14/2016	Opposition Period Ends	04/14/2016
Applicant	Roto-Die Company, Inc. 800 Howerton Lane Eureka, MO 63025 UNITED STATES		

## Goods/Services Affected by Opposition


Class 007. First Use: 0 First Use In Commerce: 0  
All goods and services in the class are opposed, namely: Dies for use with machine tools

## Grounds for Opposition

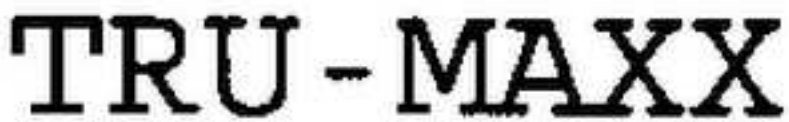
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Common law priority and confusion

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3243425	Application Date	09/28/2006
Registration Date	05/22/2007	Foreign Priority Date	NONE
Word Mark	ACCUPRO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 1996/09/01 First Use In Commerce: 1996/09/01 Machine cutting tools, namely, end mills, thread mills, cutters, cutting tool holders, taps, bits for power drills; Holding devices for machine tools, namely collets, collet chucks and adapters for attaching a cutting tool to the spindle of a power-operated machine		

U.S. Registration No.	3243426	Application Date	09/28/2006
Registration Date	05/22/2007	Foreign Priority Date	NONE
Word Mark	ACCUPRO		
Design Mark			
Description of Mark	The mark consists of the stylized word ACCUPRO.		
Goods/Services	Class 007. First use: First Use: 1996/09/01 First Use In Commerce: 1996/09/01 Machine cutting tools, namely, end mills, thread mills, cutters, cutting tool holders, taps, bits for power drills; Holding devices for machine tools, namely collets,		

	collet chucks and adapters for attaching a cutting tool to the spindle of a power-operated machine
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U.S. Registration No.	3247947	Application Date	08/27/2004
Registration Date	05/29/2007	Foreign Priority Date	NONE
Word Mark	TRU-MAXX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 2005/08/01 First Use In Commerce: 2005/08/01 COATED AND BONDED ABRASIVES, NAMELY, SANDING BELTS AND DISCS; GRINDING WHEELS Class 008. First use: First Use: 2005/08/01 First Use In Commerce: 2005/08/01 HAND-OPERATED COATED AND BONDED ABRASIVES, NAMELY, ROLLS		

Attachments	77009787#TMSN.png( bytes ) 77009795#TMSN.png( bytes ) 76610500#TMSN.png( bytes ) ROTO DIE Opposition.pdf(21537 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/ Michael R. Graif
Name	Michael R. Graif
Date	04/14/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial Nos. : 86/783572 and 86/783562  
Marks : ACCUPLUS and ACCUMAX  
International Class : 007  
Applicant : Roto-Die Co., Inc.  
Filed : October 9, 2015  
Published : March 15, 2016

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MSC SERVICES CORP.; SID TOOL CO., INC.	:	
(D/B/A MSC INDUSTRIAL SUPPLY CO.)	:	
	:	
Opposers,	:	
	:	
against	:	Opposition No. _____
	:	
ROTO-DIE CO., INC.,	:	
	:	
Applicant.	:	
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**NOTICE OF OPPOSITION**

MSC Services Corp. and Sid Tool Co., Inc. (d/b/a MSC Industrial Supply Co.), are corporations organized under the laws of the State of New York, located and doing business at 75 Maxess Road, Melville, New York 11747 (the “Opposers”), believe that they would be damaged by the registration of United States Trademark Application Serial No. 86/783572 for the mark ACCUMAX and United States Trademark Application Serial No. 86/783562 for the mark ACCUPLUS (together, the “Applications”), which were both filed by Roto-Die Co., Inc. (the “Applicant”) on October 9, 2015, and published for opposition on March 15, 2016 in International Class 7 and United States Classes 13, 19, 21, 23, 31, 34 and 35 for “Dies for use with machine tools.” Opposers hereby oppose the Applications and, as grounds for opposition, Opposers assert that:

1. Opposers market, distribute and sell a variety of tools, industrial products, and maintenance, repair and operations supplies throughout the United States. In particular, Opposers market, distribute and sell a variety of machine tools and machine tool accessories throughout the United States.

**Opposers' ACCUPRO Marks**

2. Opposers own a family of famous common law and federal trademarks and service marks for the mark ACCUPRO (the "ACCUPRO Marks") for a large group of products and services including precision measuring tools, metalworking tools, milling tools and accessories, tool-holding products, hole-making and threading tools and accessories, cutting tools, and turning and boring tools and accessories.

3. Opposers have continuously made commercial use of ACCUPRO as a trademark throughout the United States since at least 1990.

4. By virtue of such continuous use of the ACCUPRO Marks in interstate commerce, Opposers have acquired common law rights in them prior to the Applicant's filing of its intent-to-use Applications on October 9, 2015. Opposers have expended significant amounts of time, money and effort in promoting and advertising the ACCUPRO Marks, as well as the products and services distributed, marketed and sold thereunder. Consumers have come to recognize Opposers' ACCUPRO marks as identifiers of Opposers' products and services and as a single source of origin.

5. Opposer MSC Services Inc. also owns several federal trademark registrations for its family of ACCUPRO Marks, and Opposer Sid Tool Co., Inc. is a licensee of each of these registrations.

6. Opposer MSC Services Inc. is also the owner of U.S. Trademark Registration No. 3,243,425 for the ACCUPRO mark for “Machine cutting tools, namely, end mills, thread mills, cutters, cutting tool holders, taps, bits for power drills; Holding devices for machine tools, namely collets, collet chucks and adapters for attaching a cutting tool to the spindle of a power-operated machine” and recites a date of first use in commerce at least as early as September 1, 1996. Opposer MSC Services Corp., filed its application on September 28, 2006, and the United States Patent and Trademark Office (the “USPTO”) issued the Registration No. 3,243,425 on May 22, 2007. Opposer Sid Tool Co., Inc. is the licensee of Registration No. 3,243,425.

7. Opposer MSC Services Inc. is also the owner of U.S. Trademark Registration No. 3,243,426 for the ACCUPRO mark for “Machine cutting tools, namely, end mills, thread mills, cutters, cutting tool holders, taps, bits for power drills; Holding devices for machine tools, namely collets, collet chucks and adapters for attaching a cutting tool to the spindle of a power-operated machine” and recites a date of first use in commerce at least as early as September 1, 1996. Opposer MSC Services Corp., filed its application on September 28, 2006, and the USPTO issued the Registration No. 3,243,426 on May 22, 2007. Opposer Sid Tool Co., Inc. is the licensee of Registration No. 3,243,426.

8. Opposer MSC Services Inc. was the owner of U.S. Trademark Registration No. 1,759,080 for ACCUPRO mark for:

precision measuring tools; namely, timing gauges, cylinder bore gauges, tire and wheel runout gauges, disk rotor/ball joint gauges, disk rotor thickness gauges, valve seat runout gauges, injector gauges, sleeve height and counterbore gauges, dial test indicators, dial calipers, vernier calipers, digital calipers, center line gauges, micrometers, surface gauges, planer and shaper gauges, radius gauges, protractors, screw pitch gauges, thread wire sets, fillet gauges, depth gauges

and recited a date of first use in commerce at least as early as July 11, 1990. The USPTO issued the Registration No. 1,759,080 on March 16, 1993. On February 12, 2016, Registration No. 1,759,080 was cancelled by the USPTO, but Opposers common law rights in the ACCUPRO mark are valid and subsisting for the goods listed therein.

**Opposers' TRU-MAXX Marks**

9. Opposers own a family of famous common law and federal trademarks and service marks for the mark TRU-MAXX (the "TRU-MAXX Marks") and together with the ACCUPRO Marks, the "MSC Marks") for a large group of abrasive products including abrasive belts, quick change discs, surface grinding wheels, bonded abrasives, coated abrasive and other products for cutting, grinding, deburring, cleaning, finishing and polishing.

10. Opposers have continuously made commercial use of TRU-MAXX as a trademark throughout the United States since at least 2005.

11. By virtue of such continuous use of the TRU-MAXX Marks in interstate commerce, Opposers have acquired common law rights in them prior to the Applicant's filing of its intent-to-use Applications on October 9, 2015. Opposers have expended significant amounts of time, money and effort in promoting and advertising the TRU-MAXX Marks, as well as the products and services distributed, marketed and sold thereunder. Consumers have come to recognize Opposers' TRU-MAXX Marks as identifiers of Opposers' products and services and as a single source of origin.

12. Opposer MSC Services Inc. is the owner of U.S. Trademark Registration No. 3,247,947 for the TRU-MAXX mark (the "TRU-MAXX Registration") for: "coated and bonded abrasives, namely, sanding belts and discs; grinding wheels" in International Class 007 and

United States Classes 13, 19, 21, 31, 34 and 35; and “hand-operated coated and bonded abrasives, namely, rolls” in International Class 008 and United States Classes 23, 28 and 44.

The TRU-MAXX Registration recites a date of first use in commerce at least as early as August 1, 2005. MSC Services filed its trademark application on August 27, 2004 and the USPTO issued the TRU-MAXX Registration on May 29, 2007. Opposer Sid Tool Co., Inc. is the licensee of the TRU-MAXX Registration.

### **Applicant and the Applications**

13. Upon information and belief, Applicant Roto-Die Co., Inc. is a company incorporated under the laws of Missouri and located and doing business at 800 Howerton Lane, Eureka, Missouri 63025.

14. According to the Applications, Applicant intends to use the ACCUMAXX and ACCUPLUS mark in connection with “Dies for use with machine tools” in International Class 007. Opposers have been using the MSC Marks in connection with marketing, distributing and selling machine tools, machine tool accessories and metalworking products for over two decades. And Opposers own three incontestable registrations in International Class 007 for machine tool and metalworking products.

15. Opposers’ rights in the MSC Marks are therefore superior to and have priority over Applicant’s rights in the confusingly similar ACCUMAXX and ACCUPLUS marks.

16. On information and belief, Applicant and Opposers use some of the same channels of trade.

17. By reason of all of the foregoing, the public is likely to be confused or deceived with respect to the source, origin, connection, affiliation, sponsorship or approval of Applicant’s goods and/or Opposers’ affiliation, sponsorship or connection with Applicant.



18. By reason of all of the foregoing, issuance of a registration to Applicant with respect to the Application would seriously damage Opposers.

WHEREFORE, Opposers pray that this opposition be sustained and that United States Trademark Application Serial Nos. 86/783572 and 86/783562 for the marks ACCUMAX and ACCUPLUS be refused registration and that Opposers be granted all such further relief as the Trademark Trial and Appeal Board may deem necessary and just.

Respectfully submitted,

MSC Services Corp., Sid Tool Co., Inc.  
(d/b/a MSC Industrial Supply Co.)

Dated: New York, New York  
April 14, 2016

By: /s/ Michael R. Graif  
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*Attorneys for Opposers*

**CERTIFICATE OF SERVICE**

I hereby certify that, on the 14th day of April, 2016, I caused a true and correct copy of the Notice of Opposition to be served, pursuant to 37 C.F.R. § 2.101, via First Class Mail and e-mail upon:

Matthew J. Himich, Esq.  
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St. Louis, MO 63101  
Email: [mhimich@thompsoncoburn.com](mailto:mhimich@thompsoncoburn.com)

*Counsel of Record for Applicant*

/s/ Michael R. Graif  
Michael R. Graif